

REMARKS

Claims 1-10, 12-18, 20-34, and 37-44 are pending. Claims 13, 15, 23-29, and 37-44 have been withdrawn as directed to a non-elected invention/species. No claim amendments are submitted with this response.

I. **Rejection Under 35 U.S.C. § 103(a)**

The Office maintained the rejection of claims 1-10, 12, 14, 16-18, 20-22, and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,482,704 to Sweger, et al. ("Sweger") and U.S. Patent No. 6,277,893 to Babenko ("Babenko") in view of U.S. Patent No. 5,919,438 to Saint-Leger ("Saint-Leger") and U.S. Patent No. 5,720,964 to Murray ("Murray") for reasons set forth in the Office Action dated April 9, 2003. Office Action dated September 17, 2003 at page 2. Applicants respectfully disagree and traverse this rejection for the reasons of record and the following additional reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (8th ed. Rev. 1 2003). In this instance, the Office fails to establish a prima facie case of obviousness by not meeting all three criteria, including by failing to show that the references suggest all the claim limitations and failing to provide proper motivation to combine the references.

First, the Office has failed to show that the references teach or suggest all the claimed elements. In fact, the primary references Sweger and Babenko teach away from the claimed composition. Sweger teaches generally a cosmetic composition comprising amino-multicarboxylate starch derivatives as thickeners and emulsion stabilizers. Col. 1, II. 8-10. The Office specifically directs Applicants attention to Example VI for the disclosure of "a composition, which comprises substantial amount of detergent. See, example VI, wherein sodium lauryl sulfate is employed in amount of 7%." Office Action dated September 17, 2003 at page 3.

This particular example, as well as others, in Sweger also teach the use of stearic acid and triethanolamine. See, e.g., Sweger at Col. 11, II. 15-30. The combination of stearic acid, which is a C₁₈ fatty acid treated with an alkali, triethanolamine, form soap.

Babenko is similar, if not cumulative, to Sweger with the exception that it teaches replacing classical surfactants in soaps, which can cause skin irritations or allergic reactions with dimethicone copolyol. Col. 2, II. 50-57. In addition, Babenko incorporates the disclosure of Sweger into its specification at Col. 3, II. 20-53. As such, both primary references provide for the formation of "fatty acid soap" in the composition.

Unlike Sweger and Babenko, Applicants provide in the specification and claims, among others, that the composition is "free from fatty acid soaps." In particular, the specification states that "free from fatty acid soap," as recited in claim 1, means "that fatty acid soaps are present in an amount ranging for example from 0% to 1% by weight, such as from 0% to 0.1% by weight, relative to the total weight of the final

composition." Specification at page 3. Example VI of Sweger comprises at least 13%¹ fatty acid soap, which does not meet the claimed element "free from fatty acid soap."

Further, the Office relies on the secondary references (Murray and Saint-Leger) to teach "old and well-known cosmetic ingredients, particularly in shampoo compositions." Office Action dated April 9, 2003 at page 4; Office Action dated September 17, 2003 at page 4. The Office's use of Murray and Saint-Leger cannot cure the deficiencies of Sweger and Babenko. Indeed, any modification of the primary references, requiring fatty acid soaps, to obtain the claimed invention that are "free from fatty acid soaps" would necessarily contravene the teaching of these references. It is well established that it is improper to combine references if their combination would result in the destruction of the intended operation or if any references teach away from the claimed invention. *In re Laskowski*, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989). Accordingly, the combined references fail to establish a prima facie case of obviousness and to that end, Applicants respectfully request this rejection to be withdrawn.

As the record clearly establishes, there is no suggestion or motivation to combine the primary and secondary references. For this additional reason, the obviousness rejection is improper. In particular, "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is *not* sufficient to establish a prima facie case of obviousness without some objective reason to combine

¹ Example VI of Sweger comprises 8 parts by weight of stearic acid and 5 parts by weight of triethanolamine to yield 13 parts by weight of the total composition, i.e., 13% of the total composition.

the teachings of the references." M.P.E.P. § 2143 (emphases original). As such, the Office asserts that the secondary references employ ingredients that would have been "obvious to one of ordinary skill in the art because all these ingredients are old and well-known cosmetic ingredients." Office Action dated April 9, 2003. This conclusory statement, like the rejection itself, lacks objective evidence for the allegedly obvious combination and as such, fails to establish a *prima facie* case of obviousness.

Specifically, in the previous Office Action (dated April 9, 2003), the Office asserted that

[t]he employment of the particular ingredients herein, i.e., alkyl ether sulfate, the particular cationic polymer, polydimethylsiloxane, and coconut monoisopropanolamide, in a cosmetic composition, e.g., shampoo, is obvious to one of ordinary skill in the art because *all the ingredients are well-known cosmetic ingredients*, particularly in shampoo compositions.

Office Action dated April 9, 2003 at page 4. The phrase "all the ingredients are well-known cosmetic ingredients" suggests that the ingredients are "well within the ordinary skill of the art." The Office also maintained this rationale for the combination in this Office Action (dated September 17, 2003). The Office stated that

the amphoteric starch herein is taught expressly for its usefulness in shampoo composition, and other ingredients, cationic polymers, and anionic surfactants are *well-known ingredients in shampoo composition*. Therefore, a shampoo composition comprising the amphoteric starch and other well-known shampoo ingredients would have been obvious to one of ordinary skill in the art.

Office Action dated September 17, 2003 at page 4 (emphasis added). Both Office Actions only *conclude* that the ingredients are well-known in shampoo compositions but lack support by objective evidence for the combination. It is well-known, however, that

a mere conclusion cannot be used to establish a prima facie of obviousness. See M.P.E.P. § 2143. Further, “the teaching or suggestion to make the claimed combination and the reasonable expectations if success must both be found in the prior art, not in applicant’s disclosure.” See *id.* (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Similarly, the Office’s rationale is a conclusion of obviousness based in an improper hindsight reasoning. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Federal Circuit requires an examiner to show a motivation to combine the references that create the alleged case of prima facie obviousness. See, M.P.E.P. §§ 2143.01, 2145. Thus, the examiner must show reasons why one of ordinary skill in the art, confronted with the same problems as the inventor and lacking knowledge of the claimed invention, would have chosen the elements from the cited prior art references for combination in the manner claimed. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). Importantly, with respect to this motivation, the Federal Circuit has placed the burden on the examiner to present “clear and particular” evidence showing a motivation to combine the prior art references. See *In re Dembicazk*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The Office’s use of the rationale that “all the ingredients are well-known cosmetic ingredients” fails to provide “clear and particular” evidence showing a motivation to combine the secondary references with the primary references. Instead, the Office states a mere conclusion. For at least the reasons stated above, as well as those of record this rejection is improper and Applicants respectfully request its withdrawal.

II. **Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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